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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael Gauselmann

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EXAMINER

NGUYEN, BINH AN DUC

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

12/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/655,950	Applicant(s) GAUSELMANN, MICHAEL	
	Examiner Binh-An D. Nguyen	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 7,9,10,13,14,22,25,29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-6, 8, 11, 12, 15-21, 23, 24, and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 27-29 have been renumbered 27-30.

Election/Restrictions

The Response to Restriction Requirement filed September 18, 2008 has been received. According to the Response, Species S1a (claims 4 and 9) and Species S2c (claim 11) have been elected.

Upon reviewing the Restriction, the Examiner has recognized a typo was made to the Restriction Requirement sent September 9, 2008, wherein Species S1a should include claim 19 instead of claim 9. A telephone inquiry has been made to the applicant's representative, Mr. Brian Ogonowsky, on December 9, 2008; and Mr. Ogonowsky has confirmed the election of Species S1a (claims 4 and 19) and Species S2c (claim 11) without traverse. Further, Mr. Ogonowsky also acknowledged that claim 9 would be withdrawn due to non-elected species.

Further, claims 5, 6, 20, and 21 have similar features as claimed in the elected claim 11, therefore they are hereby examined. Furthermore, claims 25, 29, and 30 are

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similar to the non-elected species S2b (claim 10), S2d (claim13), and S2e (claim 14), respectively, therefore they are hereby withdrawn.

Currently, claims 1-30 are pending in the application, wherein claims 7, 9, 10, 13, 14, 22, 25, 29, and 30 are withdrawn due to non-elected species. Claims 1-6, 8, 11, 12, 15-21, 23, 24, and 26-28 are hereby examined on the merits. Acknowledgment has been made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 8, 12, 15, 17-19, 21, 23, 24, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Nordman (6,905,407).

Referring to claim 17, Nordman teaches a gaming device comprising: a first display area (30) for displaying a base game (Fig. 1B), the base game having a plurality of possible outcomes (e.g., slot symbols combinations); and at least one processor for triggering a selection of one or more features to be applied to the base game in response to a triggering event (2:45-60; 5:6-6:59); and a second display area (32) for

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displaying one or more selectors randomly selecting one or more features to be applied to the base game in response to the triggering event (Figs. 1A-5)(2:1-3:40; 7:13-8:22).

Referring to claim 1, Nordman teaches a gaming method comprising: displaying a base game (e.g., slot machine game), the base game having a plurality of possible outcomes; triggering a selection of one or more features to be applied to the base game by a triggering event (2:45-60; 5:6-6:59); and in response to the triggering event, randomly selecting one or more features to be applied to the base game Figs. 1A-5)(2:1-3:40; 7:13-8:22).

Referring to claims 2 and 18, Nordman teaches triggering a selection comprises displaying a certain symbol combination in the base game (e.g., slot game symbol combination).

Referring to claim 3, wherein triggering a selection comprises displaying at least three matching symbols across a payline in the base game, this limitation is inherent form slot machine game of Nordman (e.g., matched slot symbols in winning combination).

Referring to claims 4 and 19, Nordman teaches randomly selecting comprises randomly selecting a number of base games to which the one or more features will apply (Fig. 4).

Referring to claims 6 and 21, Nordman teaches randomly selecting comprises randomly selecting an award multiplier to be applied to the base game (8:1-12).

Referring to claims 8 and 23, Nordman teaches randomly selecting comprises randomly selecting a symbol that pays an award in the base game (8:1-12; 7:13-21).

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Referring to claims 12 and 28, Nordman teaches displaying the base game comprises displaying a random selection of symbols in at least one row and a plurality of columns (Fig. 1A, 1B).

Referring to claims 15 wherein extinguishing the one or more features randomly selected when a player cashes out of a gaming device running the base game, this limitation is inherent from the game system of Nordman in which the special game feature would end should the game player stop playing the game.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 11, 20, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordman (6,905,407) in view of Bennett (6,190,254).

Nordman teaches all limitations of claims 1-4, 6, 8, 12, 15, 17-19, 21, 23, 24, and 28 above.

Referring to claims 5, 11, 20, 27, Nordman does not explicitly teach using wild card symbols in the base game. Bennett, however, teaches using wildcard symbol in a base game of slot machine (see abstract and 3:44-63). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide wild card symbol to the base game of slot machine, as taught by Bennett, to the game system of

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Nordman to enhance game winning combinations and provide the game players more payout options thus attract more players to the game and increase casino's profit.

Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordman (6,905,407) in view of Crawford et al. (6,270,412).

Nordman teaches all limitations of claims 1-4, 6, 8, 12, 17-19, 21, 23, 24, and 28 above.

Referring to claim 16, Nordman does not explicitly teach saving into a memory the one or more features randomly selected when a player cashes out of a gaming device running the base game so the player may use the one or more features at a later time (claim 16). Crawford et al., however, teaches a gaming system wherein one or more features randomly selected is saved for the next game (see abstract). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the user a game symbol saving option, as taught by Crawford et al., to the game system of Nordman to enhance game experience, and further, allow the player to continued the game with the saved game feature to encourage the players to come back and play the game again, thus increase casino revenue.

Referring to claim 26, wherein the first display and the second display are physically in separate locations, this is a design choice since locating displays of a gaming machine apart from each other does not bring unexpected results to the game.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
Unit 3714

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